

**REMARKS/ARGUMENTS**

Claims 1-49 are pending in the application. In the previous office action all claims were rejected. In response, the Applicant filed a Request for Continued Examination and requested that the Examiner consider the arguments in the concurrently filed submission regarding the suitability of U.S. Patent 6,433,068 to Morrison et al. (hereafter referred to as "Morrison" or "the Morrison reference"). In this response, the applicant reiterates those remarks and addresses the double patenting rejection based on Morrison. Consequently, no claims are amended or cancelled. No new claims are added. Thus, upon its entry claims 1-49 are pending in the application and there is no new matter.

**RESPONSE TO NON-STATUTORY DOUBLE PATENTING REJECTION**

Claims 1-49 are provisionally rejected based on the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-18 of U.S. Pat. No. 6433068 by Morrison et al. (hereafter referred to as "Morrison").

The Applicant respectfully submits that the claims of the present application are patentably distinct from those of Morrison. As the Applicant has discussed previously, Morrison claims non-aqueous hydrocarbon gels that comprise

- 1) a hydrocarbon or hydrocarbon comprising one or more hydrocarbon-soluble substances;
- 2) a polymeric gel component comprising one or more diblock copolymers admixed with one or more triblock, radial block, or multiblock copolymers; and
- 3) a suspended or dispersed component that comprises a hydrocarbon-insoluble solid that remains uniformly suspended or evenly dispersed in the hydrocarbon gel composition.

*See, Morrison, Claim 1.*

As we have discussed previously, Morrison lists carboxylic acid esters as one possible hydrocarbon component. See Col. 4, lines 35-41. Morrison lists vegetable oils as a possible choice for the hydrocarbon. See Col. 4, lines 42-49. **Moreover, the claims of Morrison recite the hydrocarbon and the hydrocarbon comprising one or more hydrocarbon-soluble substances in the alternative.** In contrast, the claims of the present application recite a composition that includes a hydrophobic, non-polar solvent in addition to the ester. **Nothing about the claims of the Morrison disclosure suggest using such a combination of ingredients.**

Moreover, the claims also recite a particular viscosity relationship between the gelled ester, the hydrophobic, non-polar solvent, and the resultant composition. Nothing about the claims of Morrison teaches or suggests the recited viscosity relationship. With respect to the viscosity limitation, the Examiner has previously stated that the relationship is not disclosed in Morrison:

**“While the specific viscosity is not disclosed within [Morrison] it is seen to be a limitation which is either inherently anticipated or rendered obvious from the disclosure of this reference. This reference teaches the same polymers as well as solvents which fall within the scope of the description of the claims. It is reasonable to presume that the same ingredients in combination with one another would have the same properties. Applicants have failed to show or allege that such is not the case.”**

*See, Office Action of July 7, 2003, pages 2-3.*

Thus, the Examiner has stated that the disclosure of Morrison does not disclose the claimed viscosity relationship. Assuming arguendo that the components of the current application and those disclosed in Morrison are the same, the Applicant showed in the previous submission that the claimed viscosity relationship is not inherent. To reiterate, Table 10 of the present application shows that the two-phase gel compositions do not necessarily possess a viscosity that is higher than the viscosity of the gelled ester alone. *Page 55, l. 20 – Page 56, l. 4.* **Specifically Table 10 shows that the gelled ester alone has a viscosity of about 18,000 cPs. But when the gelled ester includes 30 percent of the hydrophobic, non-polar solvent the viscosity is actually lowered to about 17,000 cPs. This fact establishes that even if the presently claimed compositions have the same components as those of Morrison, as the Examiner has asserted (and the Applicant denies), compositions with an amount of a hydrocarbon of 20 to 95 weight percent as claimed by Morrison would not always have the**

**recited viscosity relationship.** Therefore, the recited viscosity relationship is not necessarily present in the compositions of *Morrison*. Because the Applicant has successfully shown that the recited properties are not inherent in the compositions claimed by Morrison, the one-way test for obviousness-type double patenting is not met. Therefore, the Applicant respectfully requests that the nonstatutory double patenting rejection be withdrawn.

**RESPONSE TO REJECTION UNDER 35 U.S.C. §103(a)**

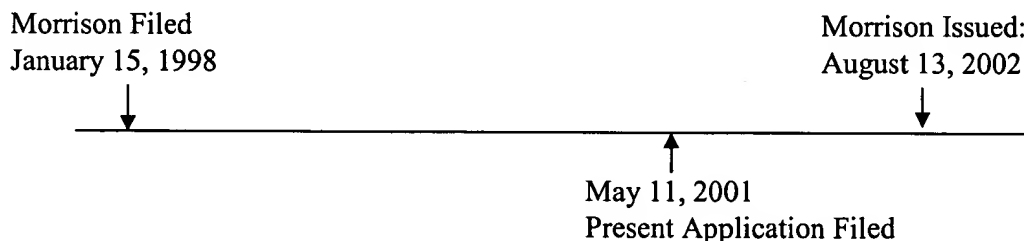
Claims 1-49 are again rejected under 35 U.S.C. §103(a) as being unpatentable over Morrison. Applicants addressed this rejection in the previous submission. For convenience, the Applicants reiterate their previous discussion of this rejection.

**A. Applicable Law**

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This change to 35 U.S.C. § 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR § 1.53(b), continued prosecution applications filed under 37 CFR § 1.53(d), and reissues. See MPEP § 706.02(k).

**B. Application of the Law****1. THE CLAIMED INVENTION IS NOT RENDERED OBVIOUS BY MORRISON BECAUSE MORRISON CANNOT BE USED AS PRIOR ART AGAINST THE APPLICATION UNDER 35 U.S.C. §103(C)**

The following timeline illustrates the timeline used by Applicant to determine that Morrison cannot be used as prior art against the current application:



As the timeline shows, Morrison was filed before the present application and issued after the present application was filed. Thus, if indeed Morrison discloses the claimed invention, it

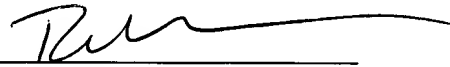
qualifies as a 102(e). Moreover, the undersigned, an attorney of record, hereby states that the claimed subject matter and the Morrison reference were, at the time when the invention of the present claims was made, subject to an obligation of assignment to the same person. *See MPEP § 706.02(l)II* (applications and references will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person). Consequently, Morrison is not a proper reference for the purposes of a rejection under 35 U.S.C. §103(a). Therefore, the Applicant respectfully requests that the rejection under 35 U.S.C. §103(a) based Morrison be withdrawn.

**CONCLUSION**

Applicant has addressed all of the Examiner's rejections. Applicant believes that the claims are now in condition for allowance and respectfully requests that the Examiner grant such an action. If any questions or issues remain in the resolution of which the Examiner feels will be advanced by a conference with the Applicant's attorney, the Examiner is invited to contact the attorney at the number noted below. No fees are due as a result of this Reply. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 10-0447, reference 42133-00009USP1 (ABDON).

Dated: September 1, 2004

Respectfully submitted,

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